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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/253,793	02/22/1999	JEFFREY C. ROBISON	4164-P	6093

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EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/253,793

Applicant(s)

ROBISON ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 November 2002 has been entered.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “plug head band, fitted between said valve plug head and a recess in said plug stem base cavity” (claim 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 has been amended to include the new limitation that the plug head band is “fitted between said valve plug head and a recess in said plug stem base cavity”. However, the drawings and the originally filed application indicate that the plug head band is fitted in the recess (see page 17, line 23). This is a new matter rejection.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites “a band” in line 2. However, it is unclear upon reading the claims in light of the specification what is meant by this term as opposed to “a plug head band” in claim 13, line 4.

Claim 19 recites the limitation “said ductile material” in line 3. There is insufficient antecedent basis for this limitation in the claim. It is unclear upon reading the claims in light of the specification what is being referred to by “said ductile material”.

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7. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 13 and 16 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Martell (US Patent Number 854,698).

Martell discloses a plug head assembly with a plug head (1), plug stem (5) with a base having a cavity (the lower portion of the stem, see Fig. 1). A plug head band (9) is fitted between the plug head and a recessed portion of the cavity behind the plug head band retainer (12), which is fastened to the base portion of the valve plug stem. If the band in claim 16 is meant to be the band of claim 13, then band (9) has two sides, one being greater than the other.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 18 and 20 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Martell as applied to claim 13 above, and further in view of Maier et al. (US Patent Number 4,325,647).

Martell is silent as to the material selection of the valve plug head and is silent as to the head and the band being different materials. Maier et al. disclose the use of a structural ceramic for the valve plug head and a different material for a similar band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the material selection of a ceramic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, Maier et al. also disclose that a motivation for using a ceramic and another material would be for elasticity and insulation purposes (see the abstract).

12. Claims 13, 15, and 17 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (US Patent Number 2,678,187).

Peters discloses a plug head assembly with a plug head (37a), plug stem (31) with a base (30) having a cavity (the lower portion of the stem, see Fig. 3). A plug head band (the periphery of 36, 90 degrees from the portion of the head contacting the seat) is fitted between the plug head and a recessed portion (38a) of the cavity. Plug head band retainer (39a), which is fastened to the base portion of the valve plug stem by a single screw. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a plurality of bolts rather than a single bolt, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (see MPEP 2144.04). Please note, the use of a threaded stem base obviates the need for nuts. Re claim 17, Peters fails to disclose the use of pins rather than bolts. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use pins in lieu of bolts because it is conventional in the prior art to use pins as substitutes for bolts with the motivation to reduce the manufacturing time as pins are assembled more quickly than bolts.

### ***Response to Arguments***

13. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

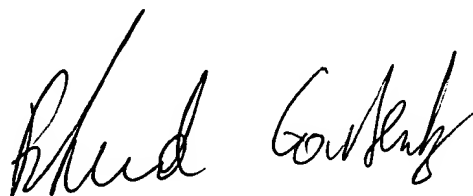
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clarke (US Patent Number 3,326,512) and Shimer (US Patent Number 1,963,685) disclose similar valves.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, or acting supervisor Ehud Gartenberg, can be reached on (703) 308-2696. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

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February 10, 2003



**EHUD GARTENBERG  
PRIMARY EXAMINER**